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10/584,051

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Jurgen Dietz

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EXAMINER

BEAUCHAINE, MARK J

ART UNIT

PAPER NUMBER

3653

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/584,051

Applicant(s)

DIETZ ET AL.

Examiner

MARK BEAUCHAINE

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 5) ☒ Claim(s) 1-81 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1-81 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-943)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

In view of the Appeal Brief filed on 28 July 2011, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Stefano Karmis/  
Supervisory Patent Examiner, Art Unit 3653

The Applicant's Appeal Brief is in response to final Office action dated 16 February 2011 is acknowledged. After further consideration, claims pending in the instant application are subject to new grounds of rejection. Accordingly, finality of said final Office action is hereby withdrawn.

### ***Claim Objections***

Claims 34 and 36 are objected to because of the following informality:

It appears that the Applicant intended for the term "to end fault" (claim 34, line 2) to be "to send fault".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10, 26, 34, 77 and 79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "operators" (claim 10, line 2) lacks sufficient antecedent basis.

The terms "service organization" and "operators" (claim 26, line 3) lack sufficient antecedent bases.

The term operator (claim 34, line 3) lacks sufficient antecedent basis.

The term “machine comprises a system (claim 77, line 2) is ambiguous because it is contrary to the description of claim 1 in which the machine is a component of the system.

The term “Service centre, comprising a system” (claim 79, line 1) is ambiguous because it is contrary to the description of claim 1 in which the service center is a component of the system.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-20, 22, 24-63 and 65-81 are rejected under 35 U.S.C. 102(a) as being anticipated by Patent Number US 7,404,515 B1 by Shepley et al. (“Shepley”).

The banknote machine system disclosed by Shepley comprises banknote processing machines 10 connected to service center 80 by means of network 76 (see Figure 3; column 12, lines 10-23). The system is configured to exchange banknote machine operating data between said machine and the service center. Log files or statistics about irregularities that occur during machine operation are transmitted to the service center which evaluates then and causes repairs to be carried out before said

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machine fails (see column 6, line 57 through column 7, line 11; column 7, line 33-53; column 12, lines 10-23).

Regarding claims 2 and 3, said exchanged data comprises software and comparison data (see column 12, lines 33-47).

Regarding claim 4, service center data enhances banknote machine data (see column 12, lines 48-59; column 39, lines 21-35).

Regarding claim 5, said network comprises the Internet (see column 15, lines 37-54).

Regarding claim 6, said machine and service center have a network interface (see Figure 3).

Regarding claim 7, a number of banknote machines are connected to one another and data is exchanged with the service center (see column 39, lines 21-35).

Regarding claim 8, said machines are assigned to an operator that monitors the machine via monitoring unit 100 (see Figure 4).

Regarding claim 9, Shepley incorporates Patent Number 5,984,178 by Gill et al. ("Gill") (see Shepley at column 12, lines 18-23). Gill discloses data memory 52 of service center 20 that stores data from banknote machines (see Gill at Figures 1 and 3).

Regarding claim 10, Shepley discloses service center 80 evaluating data of operators (see Figures 3 and 4; and column 30, line 64 through column 31, line 24).

Regarding claims 11-16, service center 80 is connected to departments 78, etc. that provide data to the service center (see Figure 3; and column 11, lines 43-58). Said departments evaluate service center data and access data of other departments and

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request data from and provide data to said machines (see column 11, line 59 through column 12, line 9).

Regarding claims 17-20, one of said departments provides software 98, etc. to operate and repair said machines and provide comparison data for said machines (see Figure 4).

Regarding claims 22 and 24, a service person is connected to said network and searches for data from the service center in a targeted manner (see column 17, lines 25-63).

Regarding claim 25, said service center communicates with service personnel by means of graphic signal at interface 100 (see Figure 4).

Regarding claim 26, communication between said machines, service center, and operator use a standard protocol (see column 15, lines 37-54).

Regarding claim 27, Gill discloses a service center request for data from banknote machines (see Gill at column 1, line 57 through column 2, line 14).

Regarding claim 28, said service center adjusts control of said machines (see column 12, lines 10-32).

Regarding claim 29, banknote machines are arranged to request data from said service center (see column 11, line 59 through column 12, line 9).

Regarding claim 30, said service center is enabled to charge data transmission fees to said machines (see column 37, lines 32-42).

Regarding claims 31 and 32, said service center provide individual presets for each banknote machine and said machines check whether new presets are available and use new available presets (see column 37, line 64 through column 38, line 11.).

Regarding claim 33, adjustments to respective banknote machines are undertaken depending on location (see column 6, lines 46-56).

Regarding claim 34, banknote machines send fault reports to said service center (see column 12, lines 10-20).

Regarding claim 35, said service center requests fault reports from said banknote machines (see Gill at column 1, line 57 through column 2, line 15).

Regarding claim 36, any faults that have occurred are displayed by said banknote machines column 7, lines 8-14; column 39, line 61 through column 40, line 2; and Figures 19 and 20).

Regarding claim 37, when said service center receives a fault report from a banknote machine it generates instructions to remove said fault (see column 39, lines 21-35).

Regarding claims 38 and 39, for certain operating processes the presence of a person is necessary and is monitored (see column 17, lines 25-63).

Regarding claims 40 and 41, said service center transmits fault information to said person (see column 31, lines 10-24).

Regarding claims 42 and 43, said service center checks whether an operator of a banknote machine is authorized to exchange data with said service center and the



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banknote machine checks for authorization of to service center to exchange data (see column 11, line 59 through column 12, line 9).

Regarding claim 44, data from said service center are loaded by said banknote machine if the data are a newer version (see column 37, line 64 through column 38, line 11).

Regarding claim 45, the exchange of data between the service center and banknote machine takes place at a specific point in time (see column 37, lines 32-42; and column 37, line 64 through column 38, line 2; and column 39, lines 21-35).

Regarding claims 46 and 47, exchange of data between said banknote machine and service center is refused by the banknote machine. As a result, the service center takes control of the banknote machine in order to perform the exchange of data (see column 39, lines 12-35 and Gill at column 38, line 51 through column 39, line 24).

Regarding claims 48 and 49, banknote machine data is backed up prior to said data being exchanged between the machine and service center. Said data can be used again if the data exchange fails (see Gill at column 14, lines 49-62).

Regarding claim 50, fundamental parts of banknote machine data 98 cannot be altered by an exchange of data (see Figure 4).

Regarding claims 51 and 52, said banknote machines check to whether data to be exchanged originate from an authorized source (see column 32, lines 13-22).

Regarding claims 53-56, payment data to be exchanged is identified and is exchanged only upon proof of the existence of the payment. Said banknote machines

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are individually identified to provide proof of payment (see column 11, line 59 through column 12, line 9).

Regarding claim 57, an amount to be paid for data is ser depending on the use of data by the banknote machines (see column 37, lines 32-63).

Regarding claims 58-60, data that is related to banknotes are transmitted to the service center where comparison data are generated from said data from the service center (see column 33, lines 28-47).

Regarding claims 61-63, said service center generates an alarm message to said banknote machines resulting from said exchanged data to place (see Gill at column 9, lines 7-18 and 33-48).

Regarding claim 65-67, said system enables a service person to set up a connection by means of computer 100 via said network to the service center to request replacement parts, enable operations and charge fees (see Figure 4; column 37, lines 32-63, and Gill at column 37, lines 1-12).

Regarding claims 68-72, the service center informs an operating person of a fault type if certain faults occur in a banknote machine and asks the person to deliver said parts to the machine location, and asks a department to provide data to clear said fault. Said data is provided by test and graphically (see column 31, lines 50-55, and column 35, line 65 through column 36, line 39).

Regarding claim 73, the service center clears faults via the network (see Gill at column 29, lines 45-65).

Regarding claims 74-76, operating persons of the banknote machine are enabled to define specific configuration data stored in a computer as the operator operates the machine (see column 17, lines 25-39).

Regarding claims 77 and 79, the service center and banknote machines are components of the banknote processing system.

Regarding claims 78 and 80, said banknote machines and service center have interfaces for connection to the network (see Gill at Figure 1).

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shepley as applied to claim 1 above, and further in view of Patent Number US 6,508,398 B1 by Estes ("Estes"). Shepley fails to disclose a further network-connected service center. Estes teaches a banknote processing machine system comprising service center 30 and further service center 68 that are in communication with banknote processing machine 36 (see sole figure, column 2, lines 11-24, and column 3, lines 5-19) for the purpose of enhancing the processing and evaluation of data transferred to and from said banknote machine. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the further service center of Estes into the system of Shepley for the purpose of enhancing the processing and evaluation of data transferred to and from said banknote machine.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shepley as applied to claim 1 above, and further in view of Patent Number US 7,092,907 B2 by Kanevsky et al ("Kanevsky"). Shepley fails to disclose a trial version of transferred data. Kanevsky teaches a data transfer system having including a trial version of data for a processing machine that is transferred from a service center to the machine and is usable for a limited time (see column 1, lines 51-56 and column 2, lines 30-39) for the purpose of restricting unauthorized use of said data. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the trial version of data of Kanevsky into the system of Shepley for the purpose of determining restricting unauthorized use of said data.

Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shepley as applied to claim 61 above, and further in view of Patent Application Publication Number US 2008/0220707 A1 by Jones et al. ("Jones"). Shepley fails to disclose and alarm message generated by the detection of a counterfeit banknote. Jones teaches a banknote processing system comprising a banknote machine in communication with service center 7015 which generates an alarm message when a counterfeit note is found (see Figure 2a and paragraph 0434) for the purpose of preventing the continued use of false banknotes. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the alarm configuration of Jones into the system of Shepley for the purpose of preventing the continued use of false banknotes.

***Response to Arguments***

Applicant's arguments with respect to claims 1-81 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK BEAUCHAINE whose telephone number is (571)272-6934. The examiner can normally be reached on 8:00AM through 5:00PM Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stefanos Karmis can be reached on (571)272-6744. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully submitted,

/MARK BEAUCHAINE/  
Primary Examiner, Art Unit 3653

/Stefano Karmis/  
Supervisory Patent Examiner, Art Unit 3653